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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,397	01/30/2004	Tomoyuki Ito	008601-0307943	2672
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EXAMINER MONDT, JOHANNES P				
ART UNIT 3663		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,397

Applicant(s)

ITO ET AL.

Examiner

JOHANNES MONDT

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 15-20, 24-29, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 and 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment filed 2/10/09 forms the basis for this Office action. In said Amendment Applicants cancelled claims 13, 14, 30 and 32 and substantially amended all remaining previously pending claims 11, 15-20, 24-29 and added new claims 33-34. Claims 12, 21-23 and 31 were previously cancelled. Claims 15-20 and 24-29 remain withdrawn. Therefore, claims 11 and 33-34 are being examined. Comments on remarks submitted with said Amendment are included below under "Response to Arguments".

Specification

2. The amendment filed 8/7/08 is once again objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the insertion of the comma changes the meaning of the original text of [0024] in that substantially is changed from adverb of "without varying" to adverb of "inserted". In response to Applicants' traverse in Remarks examiner amplifies the reason for the objection as follows: in the original text without said comma "substantially" limits "inserted", while with the insertion of the comma, "substantially" can be interpreted to limit "without varying the posture or the angle" (of operation apparatus 100 as a whole). Therefore, the meaning of the sentence substantially changed by the amendment. The question is whether this change is supported by the specification as a whole. The specification discloses (par.

[0033] on page 7) that "body 1 can be inserted smoothly into jet pump 10" (see also Figures 5A and 5B, wherein the body is seen to be within the jet pump 10). This insertion is complete, both in words ("into") and pictorially (Figures 5A and 5B). The adverb "substantially" as a qualifier for "inserted" is thus unnecessary. On the other hand, and in contrast, the angle of the guide rod 5 is not disclosed as "fixed" without qualification, but instead is only disclosed as follows: "so that the angle of the guide rod does not vary greatly during the insertion of the guide rod into the jet pump" (page 4, [0021], lines 6-7; also page 7, lines 1-2 in [0033]). Therefore, indeed, as Applicants state in their Remarks, the limitation "essentially fully inserted" is acceptable for the claiming of the apparatus body into the jet pump, as examiner had indicated during the interview on 2/3/09, but, in contrast, the implication that the posture or angle of operation apparatus 100 as a whole is not varied by the placement of the comma is not correct. Therefore, the objection to the specification under 35 USC 132(a) for new matter is maintained.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. ***Claims 11 and 33-34*** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "fixed" in "the guide rod having an incline at a fixed, predetermined, non-zero angle relative to a vertical axis of the apparatus body" (lines 13-15 of claim 11, and with a reference in claim 34 to said fixed angle (line 2)) is not supported by the specification as originally filed, and hence constitutes new matter.

5. **Claims 11 and 33-34** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "a tool, communicatively coupled to the top end of the apparatus body, configured to conduct the operation" (lines 16-17 of claim 11) is not supported by the specification as originally filed, and hence constitutes new matter.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 11 and 33-34** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of the claimed invention are vague and ill-defined due to lack of full support by a written description due to the introduction of new matter, with reference to section 4 above. In particular,

the metes and bounds of the verbiage "fixed" are unclear when construed from the specification.

8. **Claims 11 and 33-34** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The metes and bounds of the claimed invention are vague and ill-defined due to lack of full support by a written description due to the introduction of new matter, with reference to section 5 above. In particular, the metes and bounds of the verbiage "communicatively coupled to the top end" are unclear when construed from the specification.

Response to Arguments

9. Applicant's arguments filed 2/10/09 have been fully considered but they are not fully persuasive.

a. With regard to comments on Objection to the Specification, admittedly the issue is merely the insertion, into a sentence on page 4 ([0024]) of a comma between "In this manner, body 1 is inserted into the interior of the jet pump 10 substantially", and "without varying the posture of the angle of operation apparatus 100 as a whole". However, in the original text without said comma "substantially" limits "inserted", while with the insertion of the comma, "substantially" can be interpreted to limit "without varying the posture or the angle" (of operation apparatus 100 as a whole). Therefore, the meaning of the sentence substantially changed by the amendment. The question is whether this

change is supported by the specification as a whole. The specification discloses (par. [0033] on page 7) that “body 1 can be inserted smoothly into jet pump 10” (see also Figures 5A and 5B, wherein the body is seen to be within the jet pump 10). This insertion is complete, both in words (“into”) and pictorially (Figures 5A and 5B). The adverb “substantially” as a qualifier for “inserted” is thus unnecessary. On the other hand, and in contrast, the angle of the guide rod 5 is not disclosed as “fixed” without qualification, but instead is only disclosed as follows: “so that the angle of the guide rod does not vary greatly during the insertion of the guide rod into the jet pump” (page 4, [0021], lines 6-7; also page 7, lines 1-2 in [0033]). Therefore, indeed, as Applicants state in their Remarks, the limitation “essentially fully inserted” is acceptable for the claiming of the apparatus body into the jet pump, as examiner had indicated during the interview on 2/3/09, but, in contrast, the implication that the posture or angle of operation apparatus 100 as a whole is not varied by the placement of the comma is not correct. Therefore, the objection to the specification under 35 USC 132(a) for new matter is maintained.

b. Other 112 Issues: With regard to the claim language, and closely related to the issue under paragraph “a” above, and in direct response to Applicants’ explanation with quote from the specification, as to how the amendments are “amply supported” (pages 9-10 of Remarks, especially Applicants’ quote from the specification covering [0023-[0024], [0021], and [0034]):

i. The adjective "fixed" to limit the claimed "angle relative to a vertical axis of the apparatus body" (claim 11, line 14 in the marked-up copy) constitutes new matter for exactly the same reason. Applicants are referred to the following passages in the specification that characterize the angle and its variation:

(1) [0024], page 5: "Thus, guide 3 is biased to return to an appropriate position with respect to body 1". Underscore added for emphasis. It is recalled that guide 3 comprises weight 6 and guide rod 5 while only guide rod 5 makes an appreciable angle. Therefore, although there is a bias towards a specific angle, said angle is not "fixed". On the contrary:

(2) [0025], page 5: the overall arrangement of the first embodiment to which the above text pertains "enables guide 3 to vary its angle (posture) with respect to vertical axis of body 1".

Therefore, the adjective "fixed" constitutes new matter.

ii. The newly added limitation "a tool, communicatively coupled to the top end of the apparatus body" is not supported by the original specification. See [0029] in which said tool or tools is/are fixed to holes 1b; in other embodiments tool 25 is coupled to a bottom end of the apparatus body (Figures 4-6), rather than a top end of the apparatus body. Therefore, said newly added limitation constitutes new matter.

- c. Applicant Remarks on Functional Language: perusal of examiner's comments on intended use confirms his agreement with applicants that limitations of intended use or functional language do have, albeit limited patentable weight, their patentable weight residing *exclusively* in the capability of the structure of device or apparatus to perform the intended use or function.
- d. On 102 issues: weight 14 in Levesque does not feature a guide rod at fixed angle attached to it as claimed ("abuttably connected to the lower portion of the weight"), and hence in its present form no art rejection can be made.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHANNES MONDT whose telephone number is (571)272-1919. The examiner can normally be reached on 8-17.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHANNES MONDT/
Primary Examiner, Art Unit 3663